REMARKS

The Office action sent October 1, 2008 has been received and reviewed. All claims stand rejected. Reconsideration is respectfully requested.

The application is to be amended as previously set forth. All amendments and claim cancellations are made without prejudice or disclaimer. Basis for the amendment to claim 9 with respect to changing the "contractual relationship" to a –cohabitation agreement-- can be found at paragraph **[0009]** of the as filed application. Basis for the amendments to claims 9 and 12 with respect to clearly limiting application of the process to operation on a machine (*i.e.*, a computer) can be found at, *e.g.*, paragraphs **[0012]**, **[0031]** - **[0039]**, and **[0041]** - **[0046]** of the as filed application. No new matter has been added.

A. Personal Interview

Applicants would like to thank the Examiner for the courtesy extended them at the personal interview conducted on October 27, 2008 at 11:00 a.m. Applicants both attended the interview. Attending on behalf of the Office was Patent Examiner Tran Nguyen. As identified in the Interview Summary of the same date, claims 6, 9, 12, and 20 were discussed as was the Golden reference and ways to comply with 35 U.S.C. § 101. As further identified in the Interview Summary,

> "Applicant[s] described the disclosed invention. Examiner provided clarifications regarding the grounds of rejection, the applied art, and the general state of the art. Agreement was reached to the extent that additional follow-up interviews will be scheduled to review proposed claim amendments to address outstanding issues."

More specifically, applicants agreed to amend and cancel claim 20.

Applicants believe the foregoing, taken with this Amendment adequately sets forth the substance of the interview. If, however, the Office believes more detail would be desired or necessary, the Office is kindly requested to contact the undersigned, and more detail will be provided.

B. Office's Request for Clarification

In the Office action, clarification was requested as to the purported amendment of claim 17 in the previous amendment. The Office is correct. Claim 17 was not then amended.

Applicants apologize for any inconvenience.

C. 35 U.S.C. § 112 and claim 9:

The Office action rejected claim 9 as allegedly failing to comply with 35 U.S.C. § 112, first paragraph. As discussed at the interview, although applicants do not agree with the rejection, claim 9 has been amended to moot the rejection, *i.e.*, the "cohabiting same sex couple" has been amended to be an "unmarried" couple living under a cohabitation agreement. Withdrawal of the rejection is thus requested.

D. 35 U.S.C. § 101:

The claims were rejected as allegedly failing to comply with 35 U.S.C. § 101. As discussed at the interview, although applicants do not agree with the rejection, the independent claims have been amended as suggested by the Examiner to recite that "gathering data about two or more natural persons entering into a contractual relationship; entering the data into a computer; [and] calculating, with the computer, a periodic amount to be charged" so that it is clear that the invention is a computer-implemented invention, "tied to a particular apparatus or machine". <u>See</u>, *In re Bilski*, 543 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). Withdrawal of the rejection is thus requested.

E. 35 U.S.C. § 103:

Claims 1-3, 5, 8, 10, 12, 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Golden (Breaking Up Without Going Broke, copy provided in Office Action mailed 08/08/2006) in view of Official Notice and Roberts (4839804). Applicants respectfully traverse the rejection.

Claim 12 recites a method of doing business comprising: gathering data about two or more natural persons entering into a contractual relationship; entering the data into a computer; calculating, with the computer, a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences in addition to legal fees of the untimely ending of a contractual relationship between the two or more natural persons; charging that periodic amount in an insurance program over a period of time; and administering the insurance

program so that upon ending of the contractual relationship, payments covering at least some financial consequences of the ending of the contractual relationship are made as determined by the computer, wherein the financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child's education, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof.

Golden was acknowledged as not teaching "by way of computer" and was previously acknowledged as not teaching wherein the "financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child's education, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof".

Official Notice was taken that a computer would be old and well established in the art of insurance underwriting. Applicants respectfully submit that this is an inappropriate use of "Official Notice", and appears to be an attempt to relieve the Office of part of its burden in establishing a *prima facie* case of obviousness, and applicants traverse the rejection upon that grounds.

Roberts was thought to provide the other missing elements. Roberts, in its abstract, discloses

> "A method and apparatus are provided to insure a means of purchasing a floating rate zero coupon note that is designed to fund a certain future liability of uncertain value and thereby defease fully its future cost. <u>The method is a one-year renewable term insurance program that fully funds the purchase of a certain floating rate zero coupon note upon the occurrence of some catastrophic event, such as the death of the insured.</u> The system projects the expected death benefit payment and then calculates the annual insurance premium based on the expected death benefit payment, type of policy, and personal and risk characteristics of the insured." (Underlining added).

Roberts continues:

> "The floating rate zero coupon note is designed to fund a future liability whose projected due date and whose present cost are known and whose future cost is unknown but can be projected with some risk factor." (Roberts, col. 2, lines 8-11).

And,

> In view of the foregoing, it is an object of [Roberts] to provide a data processing method and apparatus for implementing a life insurance program which provides the beneficiary a benefit sufficient to cover fully the uncertain future cost of a floating rate zero coupon note, which is designed to fund an uncertain future liability whose cost can be projected on the basis of current cost data and assumptions regarding the rate of change of that data, and which automatically determines the insurance premiums that must be charged in order properly to fund the insurance program.
>
> It is a more particular object of [Roberts] to provide data processing methods and apparatus for implementing a life insurance program which provides a parent or relative who wishes to purchase floating rate zero coupon notes designed to defease the uncertain future cost of a college education for a child with assurance that the child's education will be fully funded in the event the parent or relative should die before he or she can fully purchase the full complement of floating rate zero coupon notes needed to defease the cost of the child's college education. (Roberts, col. 2, line 63 to col. 3, lines 15).

Applicants respectfully disagree with the obviousness rejection.

There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007). That reason is not apparent in the instant case absent the inappropriate application of hindsight.

There would be no reason to combine Roberts' "one-year renewable term insurance program" used to fund an uncertain cost of a college education with Golden. Roberts' goals, while laudable, "teach away" from the instantly claimed methods, which are meant to enhance the financial security of a family, not hedge against an uncertain college tuition inflation (particularly in the event of death of a parent). *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003).

The Office's reliance on Golden's paragraph 10 does not rectify the situation. Golden merely addresses "child support payments", which are a far cry from college tuition, let alone the uncertain price of future college tuition.

As the dependent claims include all of the elements of the independent claims, applicants submit that the obviousness rejections of the dependent claims also fail. In view of the foregoing, applicants request that the rejection be withdrawn.

Claims 4, 11, 14, 15, and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Golden in view of Official Notice and Roberts as applied to the parent claim above, and further in view of Covert (20050038681). Applicants traverse the rejection.

Applicants respectfully submit that the Office's use of "Official Notice" is inappropriate, and appears to be an attempt to relieve the Office of part of its burden in establishing a *prima facie* case of obviousness, and applicants traverse the rejection upon those grounds.

Furthermore, Covert is directed to "Family Protector Insurance", which insures the payor spouse's obligations (*e.g.*, by insuring the payor spouse's health or life against disability and death, respectively) after a decision to divorce has already been made. (*See, e.g.*, paragraphs [0033], [0034], [0036], [0061], [0062], [0064], [0066], [0068], and [0071] and claims 3-5 of Covert). As stated in paragraph [0033] of Covert, the problem Covert seeks to solve is that "there are no insurance products currently offered that in any way protect the payee spouse in the event that the alimony paying spouse is disabled and unable to work, in the event the payor spouse dies, or in the event the payor spouse ceases making payments or makes reduced payments." Covert goes so far in some cases as to even presume a court order requiring Family Protector Insurance has already been issued. (*See, e.g.*, paragraphs [0036], [0061], [0062], [0064], [0066], [0068], and [0071] and claims 3-5 of Covert).

While being potentially useful to the payee spouse, Covert's Family Protector Insurance is different than applicants' claimed method, which can be beneficial to everyone involved. Specifically, applicants' claims are directed to a method much more akin to long term health or life insurance wherein payments are made, but no desire is harbored by the participants to ever have the insured event actually occur (*e.g.*, divorce in the case of a married couple is much like sickness or death, respectively, in the cases of health and life insurance; they are insured against, but no one wants them to occur). (*See, e.g.*, paragraph [0008] of applicants' published application). Unlike Covert, under applicants' claim 12, the policy is contracted and entered into (and premiums have been paid) long before an end (*e.g.*, a divorce) is even contemplated by the contracting persons (*e.g.*, as was claimed in claim 1, applicants' insurance policy insured against the <u>untimely</u> end of a contractual relationship, it was not intended to solely protect one party's interests as the results of an already made decision to end the contractual relationship).

For example, as described in paragraph [0014] of applicants' published application,

installments for applicants' invention "can start at the day of marriage or before or during a marriage (or another such contract)."

Applicants' claim 12 (from which the rejected claims depend) is in stark contrast to Covert, where, in paragraph [0061], Covert states "Moreover, it should also be apparent that this transaction could be initiated at the time the divorce is finalized, at the time any child support payments are ordered, or at any time subsequent."

As further described in paragraph [0024] of applicants' published application,

> "The policy could be sold to prospective participants in the usual ways for selling life insurance. For example, insurance salesmen could offer it to new couples."

Selling an insurance policy for the untimely ending of a relationship to newlyweds or their parents, guardians or via their employers is not the same as selling Covert's Family Protector Insurance to a divorcing couple, where the damage has already been done.

This fundamental difference between applicants' invention and Covert explains why the elements of claims 6 (refunding premiums if the contractual relationship does not occur), 7 (determining the amount of coverage dependent on investment return of the premium amounts), 13 (basing the premiums on the basis of the participants' ages), and 19 (investing the premiums paid) could not be found by the Office in Covert. Such elements are irrelevant to Covert's Family Protector Insurance, where there is a short investment time frame and the time value of money cannot be as readily utilized.

Specifically, independent claim 12 (from which all of the rejected claims depend) recites that "the charges for the periodic payment start either at or before the beginning of the contractual relationship between the two or more natural persons" wherein the "financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child's education, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof.

Roberts does not rectify the situation, and the rejection should be withdrawn for that reason.

Furthermore, with respect to claim 11, applicants reviewed paragraph [0036] of Covert, and were unable to find a third party (not the payor or payee spouse) taking out the insurance

policy, such as in laws or an employer, which is an element of the claim.

With respect to claim 14, applicants reviewed paragraph [0036] of Covert, and were unable to find basing the periodic amount to be charged, in part, on the prospective participant's projected earnings, which is an element of the claim.

With respect to claim 15, applicants reviewed paragraph [0036] of Covert, and were unable to find basing the periodic amount to be charged, in part, on the prospective participant's partner's projected earnings, which is an element of the claim.

As the dependent claims include all of the elements of the independent claims, applicants submit that the obviousness rejections of the dependent claims also fail. In view of the foregoing, applicants request that the rejection be withdrawn.

Claims 6-7 and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Golden in view of Official Notice and Roberts as applied to the parent claim, and further in view of Mooney. Applicants traverse the rejection.

Applicants respectfully submit that this is an inappropriate use of "Official Notice", and appears to be an attempt to relieve the Office of part of its burden in establishing a *prima facie* case of obviousness, and applicants traverse the rejection upon that grounds. Furthermore, the cited references do not rectify the lack of a reason to combine in the manner claimed (absent impermissible hindsight), and the rejection should be withdrawn for that reason. As the dependent claims include all of the elements of the independent claims, applicants submit that the obviousness rejections of the dependent claims also fail. In view of the foregoing, applicants request that the rejections be withdrawn.

Claim 9 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Golden in view of Official Notice and alleged Applicant Admitted Prior Art (AAPA). Applicants respectfully submit that this is an inappropriate use of "Official Notice", and appears to be an attempt to relieve the Office of part of its burden in establishing a *prima facie* case of obviousness, and applicants traverse the rejection upon that grounds. Furthermore, as agreed at the interview, applicants have amended claim 9, thus mooting the rejection, to which applicants do not agree (see, e.g., pages 7-8 of previous Amendment specifically traversing the rejection).

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Golden in view of Official Notice and Roberts as applied to parent claim 12 above, and further in view of Flagg (6456979). Applicants traverse the rejection.

Applicants respectfully submit that this is an inappropriate use of "Official Notice", and appears to be an attempt to relieve the Office of part of its burden in establishing a *prima facie* case of obviousness, and applicants traverse the rejection upon that grounds. Furthermore, the cited references do not rectify the lack of a reason to combine in the manner claimed (absent impermissible hindsight), and the rejection should be withdrawn for that reason. As the dependent claims include all of the elements of the independent claims, applicants submit that the obviousness rejections of the dependent claims also fail.

Furthermore, absent hindsight and only after being appraised of applicants' disclosure, would one of ordinary skill in the art even consider combining Covert, Roberts, and Flagg in the manner set forth in the Office action. No motivation to combine the references as suggested. In view of the foregoing, applicants request that the rejections be withdrawn.

The application should be in condition for allowance. If, however, questions remain after consideration of the foregoing, the Office is kindly requested to contact applicants' attorney at the address or telephone number given herein.

Respectfully submitted,

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